

### **REMARKS/ARGUMENTS**

Reconsideration is respectfully requested of the Office Action of October 15, 2008 relating to the above-identified application.

The claims in the case are 25 to 53.

Applicants confirm election of Claims 51 and 52. Claims 25 to 50 stand withdrawn and applicants reserve the right to file divisional applications to protect these aspects of the invention.

Claim 51 has been amended to define the process by which the claimed carbon black is made in order to more particularly point out and distinctly claim the invention. Thus, Claim 51 has been converted into a linking claim. Reconsideration of the restriction required is requested.

The rejection of Claim 51 under the second paragraph of 35 U.S.C. § 112 as allegedly indefinite is traversed and reconsideration is respectfully requested.

The terms “untreated and unclassified” are defined on page 3, [0037] of the specification (US 2007/0043157) and are important features of the present invention. The term “untreated” means that the carbon black is not aftertreated. Aftertreatment could be, for example, oxidation or chemical reaction.

The term “unclassified” means that the carbon black has not been purified in an air classifier.

In Claim 51, one of the features of the inventive carbon black is the pH value. The pH value is measured according to DIN EN ISO 787-9 (Measurement of pH: In a glass envelope a

10 % suspension of the carbon black in distilled water is produced. After 1 min. of shaking and 5 min. of waiting the pH value is measured). Only for the pH measurement itself it is necessary to add water.

Another important feature of Claim 51 is that the product is an aerosol.

Withdrawal of the rejection is respectfully requested.

New Claim 53 is presented as an alternative definition of the invention and is intended to make even more precise the nature and characteristics of the claimed carbon black. Basis is found in para. [0037] of the application.

The rejection of Claims 51 and 52 under 35 U.S.C. § 103(a) as unpatentable in view of *Hisashi, et al*, US 6,087,434, is traversed and reconsideration is respectfully requested.

*Hisashi* discloses a pigment composition for a liquid toner, containing a carbon black in an amount of 50 to 0.1% by weight and a resin in an amount of 50% to 99.9% by weight, the carbon black and the resin dissolved and dispersed in a non-aqueous solvent and the solids content of the composition being at least 5% by weight, wherein the carbon black has a particle diameter in the range of 10 to 100 nm, a dibutyl phthalate (DBP) absorption of 40 to 300 ml/100g, a specific surface area (BET) of 20 to 1000 m<sup>2</sup>/g, a pH of 2.0 to 10.0, a grit content not more than 10 ppm, an ash content not more than 0.1% by weight, a polynuclear aromatic hydrocarbons (PAH) content of not more than 30 ppm, and having a total amount of oxygen per unit area 0.20 to 0.40 mg/m<sup>2</sup> calculated by dividing a total amount of oxygen obtained from composition of volatile components generated therefrom at 1,500° C. by a specific surface area thereof.

*Hisashi* discloses a process to obtain carbon blacks with the low grit (col. 9, lines 1 – 12) by treating a slurry with a wet vibrating sieve or an ultrasonic classifier. This aftertreatment of the carbon black is carried out in a slurry and therefore no aerosol is used or formed. The cited reference does not disclose any aerosols of any kind nor does the reference disclose how to obtain an aerosol.

Applicants claim an ‘untreated and unclassified’ carbon black aerosol. This carbon black is produced directly in the process of this application and there is no need for aftertreatments to produce a low grit content.

Applicants have now defined the product in terms of the process; the process not being similar in any way to the process shown in the reference. Therefore, it can not be presumed that the resulting product would be the same as applicants. Withdrawal of the rejection is respectfully requested.

Respectfully submitted,

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